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Re: **USSN 10/784,459**

Message:

The following document is attached for filing:

Supplemental Request for Reconsideration and Clarification – 14 pages.

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.	:	10/784,459 Confirmation No. 8229
Applicants	:	Allan Charles Webb et al.
Filed	:	February 23, 2004
Title	:	COMPONENT ASSEMBLY WITH FORMED SPINDLE END PORTION
Art Unit	:	3682
Examiner	:	Lenard A. Footland
Last Office Action	:	April 25, 2006
Attorney Docket No.	:	626220510021
Customer No.	:	24325

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SUPPLEMENTAL REQUEST FOR RECONSIDERATION AND CLARIFICATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Examiner is requested to do the right thing and withdraw his denial of applicant's appeal. Absent that, the Examiner is requested to provide legal and/or administrative authority for the denial, and clarification of the asserted reason for the denial.

Precedential opinions of the Board of Patent Appeals and Interferences are very rare. Only six such opinions are listed in the Appendix to the attached Memorandum dated August 10, 2005, by Michael R. Fleming, Chief Administrative Patent Judge. A Board opinion cannot be made precedential without approval of the Director of the U.S. Patent and Trademark Office.

One of the six listed precedential opinions is *Ex Parte Lemoine*, 46 USPQ 2d 1420 (Bd. Pat. App. & Int. 1994). The *Lemoine* decision is "designated as precedential on the sole issue of the construction of 35 U.S.C. §134." As of Chief Judge Fleming's memorandum dated August 10, 2005, which is after the effective date of September 13, 2004, for Rule 41.31, *Lemoine* remained a precedential opinion.

No one can believe in good conscience that the precedential *Lemoine* opinion that was approved by the Director is overruled by Rule 41.31(a)(1). The Examiner is requested to provide legal or administrative authority for his position that *Lemoine*, which was approved by the Director, erroneously interpreted the statute and is overruled by Rule 41.31(a)(1). (The Advisory Action refers to Rule 41.31(a)(2), but the correct Rule involved here is 41.31(a)(1).)

An individual Examiner cannot arbitrarily flout a precedential decision of the Board based solely on his personal belief that it was wrongly decided. An Examiner cannot fabricate imaginary reasons to ignore a precedential opinion of the Board that has approval of the Director without citing any legal or administrative authority. The Examiner's story about the precedential *Lemoine* opinion being overruled is completely unsupportable and has no basis in fact whatsoever. Furthermore, the PTO lacks authority to make a Rule that conflicts with the Statute because 35 U.S.C. §2(b)(2) provides that the U.S.P.T.O. "may establish regulations, **not inconsistent with law.**"

The O.G. Notices of September 7, 2004, pp. 1 – 137 is available on the PTO website, and includes a discussion of new Rule 41. Page 3 provides in part:

> "A new part 41 consolidates rules relating to Board practice and simplifies reference to such practices."

Page 31 of the O.G. Notices of September 7, 2004, provides in part:

> "Sections 41.31(a) (1), (a) (2) and (a) (3) were proposed to generally incorporate the requirements of former Sec. 1.191(a) (2003) and to subdivide Sec. 1.191(a) into three parts to improve readability."

Nothing in the history remotely suggests that Rule 41.31(a)(1) is anything more than a simple compilation of existing rules.

It entirely lacks merit to suggest that Rule 41.31(a) (1) has the unprecedented effect of overruling a precedential Board decision that was approved by the Director and changes the meaning of 35 U.S.C. §134 as decided in *Lemoine*, when there is no suggestion whatsoever in the history of the proposed rulemaking or in the report on the final rule of that intent. Any Rule that was intended to have such a dramatic and unprecedented effect would have unambiguously set forth the intent and purpose of the Rule both in the proposed rulemaking and in the discussion of the final rule. The Director does not promulgate "stealth" Rules.

Former Rule 1.191(a) provided in part:

> "Every applicant for a patent or for reissue of a patent, and every owner of a patent under reexamination, **any of whose claims has been twice or finally (§1.113) rejected,** may appeal from the decision of the examiner to the Board of Patent Appeals and Interferences …." (emphasis added)

New Rule 41.31(a)(1) provides in part:

> "Every applicant, **any of whose claims has been twice rejected,** may appeal from the decision of the examiner to the Board …."

35 U.S.C. §134(a) provides in part:

> "An applicant for a patent, **any of whose claims has been twice rejected,** may appeal from the decision of the primary examiner to the Board ...."

The language of the Statute and of Rule 1.191(a) when *Lemoine* was decided is the same as the language of Rule 41.31(a)(1). No one can believe in good faith that there is any difference in the meaning of the relevant language of the Statute or the Rules before, during or after the precedential *Lemoine* opinion that has the Director's approval. The Examiner is requested to specifically identify the "new" language in Rule 41.31 that overrules *Lemoine* and clarifies 35 U.S.C. §134(a).

The Examiner's contention that "any" in 41.31(a)(1) means "any one same" instead of what it means in 35 U.S.C. §134(a) is entirely lacking in merit. The Examiner is requested to identify the history in the proposed rulemaking that suggests that the meaning of the same language in 35 U.S.C. §134(a) was intended to be changed.

The Standard Operating Procedure for the Board of Patent Appeals and Interferences, as set forth in the memorandum dated August 10, 2005, by Chief Judge Fleming, requires approval of the Director before an opinion can be made precedential. See parts IV, A, 4 and 5, and V, A and B on pages 4 and 5 of the Fleming memorandum which provide as follows:

> "If the Chief Judge considers that a sufficient majority of those voting agree that the opinion should be made precedential, the opinion (along with the numerical results of the vote) will be forwarded to the Director, or the General Counsel acting by delegation on the Director's behalf, for review . . . ."
>
> "If the Director, or the General Counsel acting by delegation on the Director's behalf, agrees that the opinion should be made precedential, the Director or General Counsel will notify the Chief Judge of that determination."
>
> "The Director of the United States Patent and Trademark Office (USPTO) is both a statutory member of the Board (35 U.S.C. § 6(a)) and the official charged by statute with providing policy direction for the USPTO (35 U.S.C. § 3(a)(2)). The determination

> of which decisions or opinions shall have binding precedential affect on the USPTO generally is within the province of the Director's statutory policy role."
>
> "Review by the Director, or the General Counsel acting by delegation on the Director's behalf, is not for the purpose of reviewing or affecting the outcome of any given appeal, but strictly for determining whether the given opinion is to be made precedential."

The Director approved *Ex Parte Lemoine* being made a precedential opinion, and would not overrule it without unambiguously saying so and providing notice to that effect.

Lemoine holds that an applicant has the right to appeal when the claims have been twice rejected, and the claims do not have to be the same.

> "Under our interpretation, so long as the applicant has twice been denied a patent, an appeal may be filed." *Lemoine* 46 USPQ 2d at 1423.
>
> "The dissent also errs in construing 'any of whose claims has been twice rejected' to mean 'any of whose claims, which do not differ in substance and scope from previously rejected claims, has been twice rejected.' There is simply no support for this limited view in the statute." *Lemoine* 96 USPQ 2d at 1423.

Judge Stoner dissented in *Lemoine* on the rejection under 35 U.S.C. §103, but concurred with the majority on the interpretation of 35 U.S.C. §134 as follows at 46 USPQ 2d 1427:

> "That no claim, including none of claims 24 through 52, has retained identical wording through two separate Office actions should not and does not, in my view, deprive *Lemoine* of his right to appeal. . . ."
>
> "Where, as here, the examiner's rejection (and underlying evidence in the form of references) remains unchanged through at least two actions on the merits, despite amendments to the claims, there is no reasonable purpose served by forcing an applicant like *Lemoine* to request reconsideration without further amendment prior to exercising the right to appeal conferred by 35 U.S.C. §134. In my view, to read the statute as though it requires this futile act ill serves the applicant, for whom the right of appeal has been created by statute. Additionally, such a reading departs from a common

> sense understanding of what 'any of whose claims has been twice rejected" means in this context.'

Applicants' claims here have been rejected five times on the identical grounds, and it makes no sense that applicants should be required to once more request reconsideration before appealing.

In summary, the Examiner is requested to do the proper thing and withdraw the denial of applicants' right to appeal. Absent that, the Examiner is requested to provide some kind of legal or administrative authority or Official Notice for the proposition that Rule 31.41(a)(1) overruled the precedential opinion of *Ex Parte Lemoine*, that has the Director's approval. Applicants request the Examiner to identify a Notice from the Director's office or an interpretation from the Solicitor's office. Applicants also request the Examiner to point out in the history of the rulemaking or in the discussion of the final rule for Rule 41.31(a)(1) where there is a suggestion that *Ex Parte Lemoine* is overruled.

The Examiner is requested to elaborate on how and why "any" in Rule 41.31(a)(1) has a completely different meaning than the meaning of the same word in 35 U.S.C. §134 and in previous Rule 1.191(a). The Examiner also is requested to explain how the U.S.P.T.O. can make

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a rule that changes the meaning of a statute when the statute prohibits rules that are not consistent with law. The examiner is requested to explain why the Director would make a new "stealth" rule that secretly overrules a precedential Board opinion that was approved by the Director.

Respectfully submitted,

H. Duane Switzer
Reg. No. 22,431
Jones Day
901 Lakeside Avenue
Cleveland, OH 44114-1190
2216-586-7283

Date: August 30, 2006

MEMORANDUM

August 10, 2005

TO: Vice Chief Administrative Patent Judge
Administrative Patent Judges

FROM: MICHAEL R. FLEMING
Chief Administrative Patent Judge

Michael Fleming

Digitally signed by Michael Fleming
DN: CN = Michael Fleming, C = US, O = Chief Judge, OU = BPAI
Date: 2005.08.11 17:12:33 -04'00'

SUBJECTS: Standard Operating Procedure 2 (Revision 6)
Publication of opinions and binding precedent

The attached document supersedes Board of Patent Appeals and Interferences' Standard Operating Procedure 2 (Revision 5) dated August 11, 2004, on the same subject matter. The significant changes in this revision include:

- updating the SOP to reflect our new organizational structure;
- improving the readability of section VI Procedures For Adoption Of Binding Precedent
- allowing each judge a vote to determine whether an opinion is adopted as precedential.

Attachment
Cc: Amalia Santiago Chief Board Administrator

BOARD OF PATENT APPEALS AND INTERFERENCES

STANDARD OPERATING PROCEDURE 2 (REVISION 6)

PUBLICATION OF OPINIONS AND BINDING PRECEDENT

The following applies to the publication of opinions and adoption of binding precedent of the Board of Patent Appeals and Interferences (Board). This Standard Operating Procedure (SOP) creates internal norms for the administration of the Board. It does not create any legally enforceable rights. The procedures described in this SOP, as they pertain to determinations made by the Director, the Chief Administrative Patent Judge (Chief Judge) and any other Administrative Patent Judge (judge), are considered part of the deliberative process.

I. Background

A. The Board annually issues roughly 3500 opinions in appeals, interferences and other proceedings. These opinions are written primarily for the benefit of the parties to the proceedings. Most opinions do not add significantly to the body of law.

B. In the past, Board opinions have been officially published in the Official Gazette and the Decisions of the Commissioner of Patents, and other publications. Opinions have also been published in paper and electronic form by commercial organizations.

C. Beginning in late 1997, opinions in support of final decisions of the Board of Patent Appeals and Interferences appearing in issued patents, reissue applications, reexamination proceedings and interference proceedings open to the public have been disseminated by way of the Board's Internet web page. The Internet address for these opinions is:

http://www.uspto.gov/web/offices/dcom/bpai/bpai.htm

D. Opinions of the Trial Division have likewise been disseminated by way of links to the Board's web page. The Internet address for Trial Division opinions is:

http://www.uspto.gov/web/offices/dcom/bpai/its.htm

E. Ultimately, the publication provisions of 35 U.S.C. § 122(b) are expected to result in publication of 80% of all patent applications. Because Board opinions on appeal in applications published pursuant to 35 U.S.C. § 122(b) will be disseminated by way of the Board's Internet web page, it is expected that 80% or more of all Board opinions will be published by the USPTO on the Board's Internet web page. It is likely that some of these opinions, as well as opinions not otherwise subject to publication by the USPTO, will also be published by commercial reporters.

F. The availability of these opinions on the Board's Internet web page or from other

sources does not alter the fact that a Board opinion is precedential only if the opinion has been made precedential pursuant to the provisions of this or earlier versions of SOP 2. Public policy favors widespread publication of opinions, even if the opinions are not considered precedential.

G. Nothing in this SOP should be construed as requiring a member of the public to seek permission under this SOP to submit any nonprecedential opinion of the Board in its possession to any commercial or other entity for publication. Any opinion made available to the public that does not expressly indicate that the opinion is binding precedent of the Board or is not identified as binding precedent in the Appendix to this SOP shall be deemed to be nonprecedential.

II. Categories Of Board Opinions

There shall be two categories of Board opinions:

1. Precedential opinions
2. Nonprecedential opinions.[1]

III. Criteria For Identifying Candidates To Be Made Precedential

A. The Board's policy shall be to limit opinions which are candidates for being made precedential to those meeting one or more of the following criteria:
   1. The case is a test case whose decision may help expedite resolution of other pending appeals or applications.
   2. An issue is treated whose resolution may help expedite Board consideration of other cases or provide needed guidance to examiners or applicants pending court resolution.
   3. A new rule of law is established.
   4. An existing rule of law is criticized, clarified, altered or modified.
   5. An existing rule of law is applied to facts significantly different from those to which that rule has previously been applied.
   6. An actual or apparent conflict in or with past holdings of this Board is created, resolved, or continued.
   7. A legal issue of substantial public interest, which the Board has not treated recently, is resolved.
   8. A significantly new factual situation, likely to be of interest to a wide spectrum of persons other than the party (or parties) to a case is set forth.
   9. A new interpretation of a Supreme Court decision, a decision of the Court of Appeals for the Federal Circuit, or of a statute, is set forth.

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[1] This category includes opinions of a merits or motions panel composed of all members of the Trial Procedures Section of the Trial Division when an interference assigned to the Trial Prodecures Section involves a significant procedural issue applicable to proceedings before the Trial Procedures Section and the Trial Procedures Section judges deem it appropriate to issue an opinion binding on the Trial Procedures Section.

B. The purpose of a precedential opinion is to create a consistent line of authority as to a holding that is to be followed in future Board decisions.

C. Disposition by nonprecedential opinion does not mean that the case is considered unimportant, but only that a precedential opinion would not add significantly to the body of law.

D. The Director, the Patents Operation acting through a Commissioner or Assistant Commissioner, the appellant, a third party member of the public, or any judge may request in writing that an opinion be made precedential, by forwarding that request, along with accompanying reasons, to the Chief Judge. Typically, this request should be received within 60 days after the opinion is issued. The request and subsequent response shall be filed separately from the official record.

IV. Procedures For Adoption Of Binding Precedent

A. Any opinion of the Board satisfying one or more of the criteria identified in section III above may be adopted as precedential, either at the time of its entry or subsequent to entry, provided that the following steps are followed.

1. A majority of the merits panel that is entering or has entered the opinion agrees that the opinion should be precedential.
2. If the Chief Judge considers the opinion an appropriate candidate for being made precedential, the Chief Judge will circulate the opinion under consideration for designation as precedential to all of the judges.
3. Within a time set in the notice circulating the opinion (typically two weeks from the date of the notice), each judge shall vote "agree" or "disagree" (without further written comment or written discussion) on whether that judge agrees that the opinion should be made precedential. Barring extended unavailability (as in the case of serious illness), each judge has an obligation to vote "agree" or "disagree." If a judge does not communicate a vote within the time set, then the judge's vote will be normally considered to be in agreement that the opinion be made precedential.
4. If the Chief Judge considers that a sufficient majority of those voting agree that the opinion should be made precedential, the opinion (along with the numerical results of the vote) will be forwarded to the Director, or the General Counsel acting by delegation on the Director's behalf, for review. If the Chief Judge does not consider that a sufficient majority of those voting agree that the opinion should be made precedential, the opinion will not be forwarded for review.
5. If the Director, or the General Counsel acting by delegation on the Director's behalf, agrees that the opinion should be made precedential, the Director or General Counsel will notify the Chief Judge of that determination.
6. The opinion is then published or otherwise disseminated following notice and opportunity for written objection afforded by 37 CFR § 1.14, in those instances in which the opinion would not otherwise be open to public inspection.

B. Opinions entered by expanded panels do not automatically become precedential, but instead are subject to the procedures of this SOP. However, a prior precedential decision of a prior panel of the Board may only be overturned by decision of an expanded panel that itself has been made precedential or pursuant to an event set forth in Section VI D. The authoring judge for any decision by an expanded panel shall call the Chief Judge's attention to the opinion prior to entry of the opinion so that consideration of whether the opinion shall be made precedential can occur in advance of entry.

C. The Chief Judge will determine if the opinion is an appropriate candidate to be made precedential. If the Chief Judge is convinced that the opinion ought not to be made precedential (e.g., because the Chief Judge believes the opinion does not meet the criteria of Part III above), the Chief Judge is under no obligation to consult other judges.

D. Where a written request for a precedential opinion has been received, the Chief Judge shall prepare an order indicating that the opinion has, or has not, been adopted as precedent of the Board under the procedures of this Standard Operating Procedure.

E. The opinion will become precedential upon being published or otherwise disseminated.

F. Clearance for publication, if needed under the rules, will be obtained by the Chief Judge.

V. Scope Of Director's And Chief Judge's Review

A. The Director of the United States Patent and Trademark Office (USPTO) is both a statutory member of the Board (35 U.S.C.§ 6(a)) and the official charged by statute with providing policy direction for the USPTO (35 U.S.C.§ 3(a)(2)). The determination of which decisions or opinions shall have binding precedential affect on the USPTO generally is within the province of the Director's statutory policy role.

B. Review by the Director, or the General Counsel acting by delegation on the Director's behalf, is not for the purpose of reviewing or affecting the outcome of any given appeal, but strictly for determining whether the given opinion is to be made precedential.

C. Neither review by the Chief Judge, nor consultation with judges not assigned to the merits panel, is for the purpose of reviewing or affecting the outcome of any given appeal, but strictly for determining whether the given opinion is to be made precedential.

VI. Precedent Binding Upon The Board

A. The following are considered precedent binding upon the Board:

1. An opinion of the Supreme Court.
2. An *en banc* decision of the Court of Appeals for the Federal Circuit.
3. A decision of the Court of Appeals for the Federal Circuit, or its predecessors, the Court of Customs and Patent Appeals (CCPA) and the Court of Claims, which the Court of Appeals for the Federal Circuit considers binding precedent. *See Newell Cos., Inc. v. Kenney Mfg. Co.*, 864 F.2d 757, 765, 9 USPQ2d 1417, 1423 (Fed. Cir. 1988); *UMC Elecs. Co. v. United States*, 816 F.2d 647, 652 n.6, 2 USPQ2d 1465 , 1468 n.6 (errata) (Fed. Cir. 1987), *cert. denied*, 108 S.Ct. 748 (1988); *South Corp. v. United States*, 690 F.2d 1368, 1370, 215 USPQ 657, 658 (Fed. Cir. 1982) (*en banc*).
4. An opinion of the Board made precedential by the procedures contained in this or earlier versions of SOP 2.

B. Judges encountering conflicts in the decisions of the Court of Appeals for the Federal Circuit, the CCPA, and/or the Court of Claims should call the conflict to the attention of the Chief Judge.

C. All other opinions of the Board that are published or otherwise disseminated are not considered binding precedent of the Board.

D. All judges, including the Chief Judge, are bound by a published or otherwise disseminated precedential opinion of the Board unless the decision supported by the opinion is (1) modified by the Court of Appeals for the Federal Circuit, (2) inconsistent with a decision of the Supreme Court or the Court of Appeals for the Federal Circuit, (3) overruled by a subsequent expanded panel, or (4) overturned by statute.

VII. Nonprecedential Opinions

A. When authoring an opinion, a panel or a single judge may determine that the opinion may be published in a commercial reporter or not published in a commercial reporter. (Decisions on appeal in applications open to the public under the provisions of 35 U.S.C. § 122(b) will be published on the Board's Internet Web page without regard to the panel's or individual judge's determination.) The fact that a panel or judge determines that an opinion may be published in a commercial reporter does not mean that it must be published; it means only that the authoring panel or judge has no objection to its being published in a commercial reporter.

B. When the panel or the judge has no objection to publication of the opinion in a commercial reporter, the opinion should contain the appropriate one of the following headings on the first page:

> The opinion in support of the decision being entered today is ***not*** binding precedent of the Board.
>
> The opinion in support of the decision being entered today

> is binding precedent of the Trial Procedure Section of the Board of Patent Appeals and Interferences. The opinion is otherwise ***not*** binding precedent of the Board.

C. These headings will typically be used in situations where, although the opinion does not add significantly to the body of law, the opinion may nevertheless be helpful to more than just the parties involved, and where the opinion recounts the facts of the case and the legal authorities relied upon in a way that permits a full understanding of the issues and the board's determination by recourse to the opinion alone.

D. When a panel does not consider publication of the opinion in a commercial reporter warranted, the opinion should contain the following heading on the first page:

> The opinion in support of the decision being entered today was ***not*** written for publication and is ***not*** binding precedent of the Board.

E. Any panel or judge seeking to have a non-precedential opinion published shall forward the opinion to the Chief Judge. Clearance, if needed under the rules, will be obtained by the Chief Judge consonant with 37 CFR § 1.14. After clearance required by the rules is obtained, or when clearance is not needed, the opinion will be published or otherwise disseminated.

F. A non-precedential opinion that is published or otherwise disseminated is not binding on other judges and/or panels.

Appendix: Opinions Approved as Binding Precedent of The Board of Patent Appeals and Interferences pursuant to Standard Operating Procedure 2 which have not been modified or reversed by the Federal Circuit:

Reitz v. Inoue, 39 USPQ2d 1838 (Bd. Pat. App. & Int. 1995)
Ex parte Bhide, 42 USPQ2d 1441 (Bd. Pat. App. & Int. 1996)
Ex parte Lemoine, 46 USPQ2d 1420 (Bd. Pat. App. & Int. 1994)
Basmadjian v. Landry, 54 USPQ2d 1617 (Bd. Pat. App. & Int. 1997)
Ex parte Yamaguchi, 61 USPQ2d 1043 (Bd. Pat. App. & Int. 2001)
Ex parte Eggert, 67 USPQ2d 1716 (Bd. Pat. App. & Int. 2003)